UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,117	01/29/2002	Yutaka Iyoki	P21951	1205

7055	7590	03/20/2006	EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 January 2006*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-25* is/are pending in the application.

    4a) Of the above claim(s) *1-12* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____ .

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

Response to Arguments

Applicant's arguments with respect to claims 13-25 have been considered but are moot in view of the new ground(s) of rejection. Examiner notes that claims 1-12 are cancelled by the applicant. Claims 13- 25 are discussed below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 18 and 23, it is unclear to the meaning of the "IP address ... *based on the IP address of the scanner apparatus included in the response to the predetermined packet*"

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 13-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Choi (US 2002/0040397) in view of Matsuura (US 2001/0021945).

As per claims 13,19 and 24, Choi discloses a scanner apparatus configured to

scan image data, comprising:

an interface configured to be connected to a terminal apparatus via a network,

the terminal apparatus being configured to be connected to a DHCP (Dynamic Host

Configuration Protocol) server via the network, the DHCP server assigning one IP

address to the terminal apparatus, the one IP address being assigned to the terminal

apparatus for a predetermined time period; and (Figure 3, [0028], [0031], [0034])

another IP address assigned to the terminal apparatus when the predetermined

time period elapses, the another IP address being assigned to the terminal apparatus

for a further predetermined time period by the DHCP server, the another IP address

being distinct from the one IP address.   ([0052]; One of ordinary skill in the art knows

that the release process in DHCP allows an apparatus to receive a different ip address

when the lease, which reads on the limitation as the predetermined time period, expires,

and this allows a different ip address to be assigned and reads on the claim language

limitation "the another IP address being distinct from the one IP address")

Choi fails to disclose the controller being further configured to receive, from the

terminal apparatus, and to transmit the scanned image data to the terminal apparatus

during the further predetermined time period. Matsuura discloses the controller being

further configured to receive, from the terminal apparatus, and to transmit the scanned

image data to the terminal apparatus during the further predetermined time period. ([0007]) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to receive, from the terminal apparatus, and to transmit the scanned image data to the terminal apparatus during the further predetermined time period in the disclosure of Choi. The motivation for doing do would have been to allow for parallel sending of data to a plurality of computers via a network. ([0006])

As per claim 14, Choi / Matsuura discloses the scanner apparatus according to claim 13. Choi discloses further comprising a memory configured to store the one IP address assigned to the terminal apparatus, wherein, when the controller receives the another IP address assigned to the terminal apparatus, the controller deletes the one IP address stored in the memory and stores the another IP address in the memory. ([0041], [0052]; Figure 3: item 22; IP addresses allocated to the devices of the home network 1 are managed by the lookup server 22)

As per claim 15, Choi/ Matsuura discloses the scanner apparatus according to claim 13, further comprising a memory configured to store the one IP address assigned to the terminal apparatus, wherein when the controller receives, from the terminal apparatus, the one IP address assigned to the terminal apparatus and the predetermined time period corresponding to the one IP address, the controller stores, in the memory, the one IP address assigned to the terminal apparatus and the predetermined time period corresponding to the one IP address and deletes the one IP

address stored in the memory when the predetermined time period elapses. ([0041],

[0052]; Figure 3: item 22; IP addresses allocated to the devices of the home network 1

are managed by the lookup server 22)

As per claims 16 and 21, Choi / Matsuura discloses the scanner apparatus

according to claim 13, wherein the controller receives, from the terminal apparatus, a

predetermined packet, the predetermined packet being configured to search for the

scanner apparatus connectable to the terminal apparatus, the predetermined packet

including identification information, the identification information identifying the terminal

apparatus, and the controller transmits, to the terminal apparatus, a response to the

predetermined packet when the identification information included in the predetermined

packet matches identification information of the scanner apparatus. ([0049],[0050])

As per claims 17 and 22, Choi / Matsuura disclose the scanner apparatus

according to claim 16, and Choi discloses wherein the response to the predetermined

packet includes an IP address of the scanner apparatus. ([0050]; using transmitted ip

address)

As per claims 18 and 23, Choi/ Matsuura discloses the scanner apparatus

according to claim 17. Choi fails to disclose receiving IP address of the scanner

apparatus based on IP address on the scanner apparatus included in the response to

the predetermined packet. Matsuura discloses receiving IP address of the scanner

apparatus based on IP address on the scanner apparatus included in the response to the predetermined packet. ([0007]) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to disclose receiving IP address of the scanner apparatus based on IP address on the scanner apparatus included in the response to the predetermined packet in the disclosure of Choi. The motivation for doing do would have been to allow for parallel sending of data to a plurality of computers via a network. ([0006])

As per claim 20, Choi/ Matsuura discloses the scanner apparatus according to claim 19. Choi discloses the terminal apparatus according to claim 19, wherein the controller transmits, to the scanner apparatus, a predetermined packet, the predetermined packet being configured to search for the scanner apparatus connectable to the terminal apparatus, and transmits the IP address assigned to the terminal apparatus to the scanner apparatus which transmits, to the terminal apparatus, a response to the predetermined packet. ([0050], Figure 5)

As per claim 25, Choi discloses a method for storing an IP address of a terminal apparatus in a scanner apparatus, the terminal apparatus being connected to a DHCP (Dynamic Host Configuration Protocol) server via a network, the DHCP server assigning one IP address to the terminal apparatus, the one IP address being assigned to the terminal apparatus for a predetermined time period, the scanner apparatus being

connected to the terminal apparatus via the network and transmitting scanned image

data to the terminal apparatus, (Figure 3, [0028], [0031], [0034]) the method comprising:

storing the one IP address assigned to the terminal apparatus in the scanner

apparatus, ([0041], [0052]; Figure 3: item 22; IP addresses allocated to the devices of

the home network 1 are managed by the lookup server 22)

deleting the one IP address stored in the scanner apparatus when the

predetermined time period elapses, the predetermined time period indicating a time

period for which the one IP address is assigned to the terminal apparatus, ([0041],

[0052]; Figure 3: item 22; IP addresses allocated to the devices of the home network 1

are managed by the lookup server 22)

the another IP address being assigned to the terminal apparatus for a further

predetermined time period by the DHCP server, the another IP address being distinct

from the one IP address; ([0052]; One of ordinary skill in the art knows that the release

process in DHCP allows an apparatus to receive a different ip address when the lease,

which reads on the limitation as the predetermined time period, expires, and this allows

a different ip address to be assigned and reads on the claim language limitation "the

another IP address being distinct from the one IP address")

storing the received another IP address assigned to the terminal apparatus in the

scanner apparatus, and ([0041], [0052]; Figure 3: item 22; IP addresses allocated to

the devices of the home network 1 are managed by the lookup server 22)

Choi fails to disclose receiving at the scanner apparatus the one and another IP

address, transmitting, at the scanner apparatus, the scanned image data to the terminal

apparatus during the further predetermined time period, based on the another IP address assigned to the terminal apparatus. Matsuura discloses receiving at the scanner apparatus the one and another IP address, transmitting, at the scanner apparatus, the scanned image data to the terminal apparatus during the further predetermined time period, based on the another IP address assigned to the terminal apparatus. ([0007]) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to receive one and another IP address from the terminal apparatus, and to transmit the scanned image data to the terminal apparatus during the further predetermined time period in the disclosure of Choi. The motivation for doing do would have been to allow for parallel sending of data to a plurality of computers via a network. ([0006])

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Toyoda (US 6,880,019) discloses a PC sends a pair of a self-IP address and a mail address to a RARP processing section in response to the RARP request. After obtaining an IP address of this PC, a scanner scans an original, and generates e-mail to which the image is appended. However, it is was not used in the rejection, yet listed in the IDS, due to the same assignee as this applicant. A close review of these references is strongly recommended.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Chirag R. Patel whose telephone number is (571)272-

7966. The examiner can normally be reached on Monday to Friday from 7:30AM to

4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Rupal Dharia, can be reached on (571) 272-3880. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

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(toll free).

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER